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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,294	09/26/2003	Shubhasheesh Anand	50269-0600	9385
29989 7590 04/11/2008 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110				
EXAMINER CHAMPAGNE, DONALD				
ART UNIT		PAPER NUMBER		
3688				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,294

Applicant(s)

ANAND ET AL.

Examiner

Donald L. Champagne

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102 and 35 USC § 103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17, 18, 20-23, 25-27, 29-32, and 34 are rejected under 35 U.S.C. 102(2) as being anticipated by Emens et al. (US007076443B1, hereafter "Emens").
4. Emens teaches (independent **claims 17 and 26**) a machine-implemented method and machine-readable medium, the method comprising:

storing, remote to a client, user specific data that reflects one or more user interests of a user, wherein said user specific data is collected using a search website that provides searching functionality (see at least column 2, lines 32-38);

retrieving a set of sponsored content based, at least in part, on said user specific data (see at least column 2, lines 34-38 wherein the advertisements are sponsored content);

integrating said sponsored content into "a display generated by a website other than said search website" (*advertising ... placed on popular web sites*, col. 1 lines 18-21, with the claim language interpretation given in para. 5-6 below).

Art Unit: 3688

5. Claims 17 and 26 are limited to "a display generated by ... a website other than said search website", but this makes no sense since a display cannot be "generated by a website". A display can only be generated by a display device. Hence, from support in para. [0027] of the published application¹, the phrase "integrating said sponsored content into a display generated by a website other than said search website" was interpreted to mean "integrating said sponsored content into the content from a website other than said search website".
6. However, the term "integrating" is not given a "clear definition" in the specification (MPEP § 2111.01), so the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe the invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example. In the instant case, the examiner interprets "integrating" to mean any combination of sponsored content and content from a website other than said search website. The banner ad taught by Emens (col. 1 lines 18-21) reads on that.
7. Claims 18 and 27: Emens teaches the method and machine-readable medium of Claims 17 and 26, respectively, as set forth above. Emens further teaches wherein said user specific data includes a word or phrase upon which the user search for using said search website (see at least column 2, lines 32-35).
8. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to claims 21, 22, 30 and 31.
9. Claims 23 and 32: Emens teaches the method and machine-readable medium of Claims 17 and 26, respectively, as set forth above. Emens further teaches displaying, at least a portion of, said set of sponsored content on a website other than said search Website (see

¹ US 20050076130A1.

Art Unit: 3688

at least column 5, lines 54-64 wherein a product advertisement page is formatted and displayed upon user selection).

10. Claims 25 and 34: Emens teaches the method and machine-readable medium of Claims 23 and 32, respectively, as set forth above. Emens further teaches wherein the portion of sponsored content displayed on said website is a banner advertisement (col. 5 lines 8-10).
11. Emens also teaches claims 20 and 29 (col. 5 lines 60-62, where formatted reads on a "design", a "motif", an "organization" and a "layout" of said advertisements/pre-existing content).
12. Claims 19, 24, 28 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens in view of McElfresh et al. (US006907566B1, hereafter "McElfresh").
13. Claims 19 and 28: Emens teaches the method and machine-readable medium of Claims 17 and 26, respectively, as set forth above. Emens does not teach wherein said sponsored content has a higher priority on said display than other content on said display. McElfresh does teach such a limitation (see at least column 4, lines 33-37 wherein ads are prioritized based on click-through percentage). Because advertisers want to be at or near the top of a user's display in order to get their money's worth of brand recognition (see McElfresh in at least column 2, lines 1-5), it would have been prima facie obvious at the time the invention was made to combine the teachings of Emens, wherein a system and technique for automatically associating related advertisements to individual search results terms of a search result set is taught, with the teachings of McElfresh, wherein a method and system for optimum placement of advertisement on a webpage is taught.
14. Claims 24 and 33: Emens teaches the method and machine-readable medium of Claims 23 and 32, respectively, as set forth above. Emens does not teach wherein the portion of sponsored content displayed on said website is displayed using the same design, motif, organization, or layout as other text on said website. McElfresh does teach such a limitation (see at least column 6, lines 60-65 wherein displaying the sponsored content using the same design, motif, organization or layout as other text is a constraint on the display of the sponsored content). Because a common and effective approach to online advertising is displaying and targeting pre-selected advertisements to a particular audience (see Emens in at least column 1, lines 33 - 36), it would have been prima facie obvious at the time the invention was made to combine the teachings of Emens, wherein a system and technique

Art Unit: 3688

for automatically associating related advertisements to individual search results terms of a search result set is taught, with the teachings of McElfresh, wherein a method and system for optimum placement of advertisement on a webpage is taught.

15. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens in view of Rothschild (US20010047294A1). Emens does not teach displaying sponsored content with email messages in an IM client. Rothschild teaches displaying sponsored content (advertisement) with email messages in an IM client (para. [0017]). Under KSR v. Teleflex (82 USPQ 2d 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Emens teaches no medium restrictions the distribution of advertising, but does not expressly teach email with an IM client. Rothschild teaches advertising with email and an IM client.

Response to Arguments

16. Applicant's arguments filed with an amendment on 15 January 2008 have been fully considered but they are not persuasive. The arguments have been addressed by the revised rejection presented herein.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The

Art Unit: 3688

examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.

20. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
22. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
23. Applicant may have after final arguments considered and amendments entered by filing an RCE.
24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

9 April 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688